

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

EDWARD J. FIORE

Serial No.: 09/688,717

Filed: October 16, 2000

For: Arbitrated Loop Port Switching

Attorney Docket No.: 98-046-NSC (STK98046PUS)



Group Art Unit: 2664

Examiner: not known

**DECLARATION BY MARK D. CHUEY
OF FACTS PERTAINING TO DILIGENT EFFORT
IN OBTAINING INVENTOR SIGNATURE**

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

This declaration has been prepared to show diligent effort, required under 37 C.F.R. § 1.47(b), in attempting to obtain a signed declaration from Edward J. Fiore, the sole named inventor on the above-mentioned patent application. This declaration was prepared in response to a Notice of Missing Parts mailed December 8, 2000.

The following facts are stated to the best of my recollection:

Storage Technology Corporation (StorageTek), the Assignee of the present invention, and Cisco Systems, Inc. (Cisco) are involved in litigation. Prior to the patent application filing date, Mr. Fiore left StorageTek to work for NuSpeed, Inc., which was subsequently acquired by Cisco.

On January 9, 2001, I sent Mr. Fiore a copy of the patent application together with a declaration and an assignment via certified mail. A copy of the cover letter is attached as Exhibit A and a copy of the receipt postcard, signed by Mr. Fiore on January 12, 2001, is attached as Exhibit B.

On January 15, 2001, Mr. Fiore sent an electronic mail to Timothy Schulte, Patent Counsel at StorageTek, citing U.S. Patent Nos. 5,751, 715 and 6,118,776 and stating "This art would make my Patent void." Mr. Fiore asked Mr. Schulte to call him. A copy of this electronic mail is attached as Exhibit C. This electronic mail was forwarded to me in an

electronic mail dated January 16, 2001 asking me to contact Mr. Fiore. I called Mr. Fiore on or about January 16, 2001 and left a message requesting that he call me back.

On January 19, 2001 I received a telephone call from Joe Hammell, who identified himself as an attorney from Dorsey & Whitney LLP representing Cisco. Mr. Hammell asked me to have no further contact with any former StorageTek employee now working for Cisco. Mr. Hammell also indicated that he would send a letter indicating that no former StorageTek employee currently working for Cisco would sign any document related to a StorageTek patent application. I told Mr. Hammell that I would forward a copy of this letter to the U.S. Patent and Trademark Office as evidence that inventors now working for Cisco were unwilling to sign patent application declarations.

After having received no letter from Mr. Hammell, I sent him a letter on February 23, 2001. This letter summarized our telephone conversation, including my understanding that Mr. Fiore refused to sign any declaration or assignment. The letter also mentioned other former StorageTek inventors working for Cisco and involved with other patent applications. A copy of this letter is appended as Exhibit D.

Mr. Hammell responded by letter on March 2, 2001, appended as Exhibit E. In this letter, Mr. Hammell reiterated that I was to contact Mr. Fiore only through Dorsey & Whitney. Mr. Hammell did not indicate whether or not Mr. Fiore would sign papers associated with the application.

In his letter of March 2, 2001, Mr. Hammell made several inaccurate statements about our telephone conversation and about my conduct with regards to Mark Bakke and Timothy Kuik, former StorageTek inventors involved with other patent applications. In particular, Mr. Hammell asserted that my contacts with Mr. Bakke and Mr. Kuik "constituted serious ethical breaches." Mr. Hammell attempted to use this argument in a motion to have attorneys at Brooks & Kushman disqualified from litigation between StorageTek and Cisco. This motion was decided against Mr. Hammell's position by Susan R. Nelson, United States Magistrate Judge, on March 13, 2001. The resulting opinion is appended as Exhibit F. In this opinion, Judge Nelson stated the following at page 12:

Mr. Chuey's September and December telephone correspondence and letter correspondence do not present a basis for disqualification. (Chuey Aff., Doc. No. 20, ¶¶ 6, 7, 8, 12.)

All of Mr. Chuey's contacts with Mr. Bakke were made in effort to secure Mr. Bakke's signature on patent applications for patents developed during Mr. Bakke's employment at StorageTek. In addition, Cisco's legal department was aware that StorageTek was seeking Mr. Bakke's signature on the patent applications. (Kuik Aff., Doc. 17, Ex. C.) Mr. Chuey's contacts with Mr. Bakke did not violate [Minnesota Rule of Professional Conduct] 4.3, and therefore cannot provide a basis for disqualification.

On March 28, 2001, I sent a second letter to Mr. Hammell, appended as Exhibit G. This letter requested Mr. Hammell to forward the enclosed declaration and assignment to Mr. Fiore for signature. The letter also asked Mr. Hammell to verify Mr. Fiore's address. The letter indicated, erroneously, that I had not previously forwarded a copy of the application and formal papers to Mr. Fiore. I indicated to Mr. Hammell that if I did not hear from Mr. Fiore by April 7, 2001, I would assume that he refused to sign.

On March 29, 2001, Mr. Hammell responded with a letter, appended as Exhibit H. Mr. Hammell indicated that he forwarded the documents to Mr. Fiore. Mr. Hammell also indicated that the April 7 deadline was not reasonable since Mr. Fiore had not been sent a copy of the application. Mr. Hammell further indicated that, to his knowledge, Mr. Fiore had not refused to sign any documents.

On March 30, 2001, I responded with a letter, appended as Exhibit I. In reviewing my records, I found my letter of January 9 and Mr. Fiore's signed receipt. I forwarded a copy of the receipt to Mr. Hammell together with a statement that, in light of the almost three months Mr. Fiore had to review the application, a deadline of April 7 was appropriate.

On April 4, 2001, Mr. Hammell responded with a letter, appended as Exhibit J. In this letter, Mr. Hammell provided the following statement:

Ed Fiore has asked me to inform you that the patent documents you asked him to sign relate to technology which is covered by existing patents, specifically US Patent 6,118,776 held by Vixel, and US Patent 5,751,715 held by Gadzoox. I am enclosing some documents relating to these existing patents.

The '715 patent was submitted with an Information Disclosure Statement filed with the application. The '776 patent and what appear to be three papers attached to Mr. Hammell's

letter are submitted with an Information Disclosure Statement filed together with a response to the Notice of Missing Parts.

Based on the above facts, I believe that I have diligently attempted to obtain a signed declaration from Mr. Fiore.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark D. Chuey', with a long horizontal flourish extending to the right.

Mark D. Chuey
Reg. No. 42,415

Date: May 8, 2001

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